

II. Remarks

In the Office Action of February 21, 2003, claims 1-38 and claims 41-46 are pending. Claims 1-38 and claims 41-46 stand rejected. In this response, claims 1, 12, 37 and 42-46 have been amended. Claim 41 has been cancelled. Reconsideration and allowance of all pending claims is respectfully requested in view of the following remarks.

A. Rejections Under 35 U.S.C. §112.

1. Rejection Of Claims 41-43 Under 35 U.S.C. §112, Second Paragraph.

Claims 41-43 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Specifically, these claims are rejected because they are dependent on a cancelled claim.

Claim 41 has been canceled and claims 42-43 have been amended to depend from claim 37. Therefore, the rejection based on improper dependency is traversed.

2. Rejection of Claims 1-38 and 41-46 under 35 U.S.C. §112, First Paragraph.

Claims 1-38 and 41-46 stand rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not disclosed in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

a. Rejection Based on Failure to Claim Benefits of the Invention.

The Examiner has maintained that each pending claim is indefinite because Applicant has not recited the benefits of the invention, i.e., that the claims do not state that the claimed invention is “firm, malleable enough to allow cleat penetration and easy repair, resistant to being pulled up in clumps, dust free and water resistant.” Applicant previously argued in response to the last office action that there is no requirement to list the benefits of the invention in the claims. The Examiner now repeats the argument but has still has not pointed to any law or USPTO regulations supporting this position. The Applicant argues that there is no such law or regulation. Indeed, the requirement for a

proper claim as stated in 35 U.S.C. § 112 is that “The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as the invention.” Therefore, only the subject matter of the invention needs to appear in the claims. The benefits that may flow from the subject matter of the invention do not need to be claimed. Thus, this rejection is improper and should be removed.

b. Rejection of Claims 44-46.

Claims 44-46 are rejected because they do not recite the required presence of wax and clay. Claim 44 has been amended to add the termination of “clay,” so claim 44 and the claims depending therefrom (claims 45 and 46) now include the limitations of clay and wax.

c. Rejection of Claims for Failure to Enable the Choosing of the Proper Wax.

The Examiner also appears to take the position that the invention is limited to the preferred embodiments of wax described in the Detailed Description section, and now argues that the specification does not “teach” someone skilled in the art how to determine which wax to use. The Applicant traverses this position for several reasons.

First, as a matter of law patents are generally not limited to the preferred embodiments. Second, a patent specification does not have to explicitly “teach” someone how to determine if a particular product falls within the claimed scope of the invention, in this case such knowledge is inherent to those skilled in the art how to make the invention without undue experimentation and the Examiner has offered no objective reasoning to refute it. Further, the Examiner offered no reasoning whatsoever in the first rejection and this rejection should not have been final.

Next, the Examiner argues that since the background teaches that there are combinations of soil, clays and organic binders that fail to perform the functions required of the invention, there are a significant number of combinations that otherwise would fall within the scope of the claims that are inoperable. This analysis is incorrect. The combinations of soil of the prior art in the Background section are different than the claimed invention in many ways, and particularly in that the

combinations of materials are different than the claimed combinations. Therefore, contrary to the Examiner's argument, this does not result in a significant number of inoperative combinations that would otherwise fall within the scope of the claims. Indeed, the art discussed in the Background would not fall within the scope of the claims. Thus the premise upon which this argument is based is flawed and should be rejected.

The only limitation of the type of wax that may be used is that the wax "make the surface material malleable" and "add cohesiveness to the particles." Page 6, ll. 11-12. Any wax capable of performing these functions may be used. Page 6, ll. 12-13. Applicant has added this limitation to the pending claims, although it is believed unnecessary since it is inherent. This teaches one of ordinary skill in the art the type of wax to be used. Applicant also notes that the prior art references are not limited to any particular type of wax, which is strong evidence that persons skilled in this art know how to select appropriate waxes. As noted in *In re Skirvan*, 166 USPQ 85, 88 (CCPA 1970), "We hold that claims need not recite such factors where one of ordinary skill in the art, to whom the specification and claims are directed, would consider them obvious." Therefore, the claims of the present invention are fully enabled and this rejection must be withdrawn.

B. Rejections Under 35 U.S.C. §102(b).

1. U.S. Patent No. 4,925,493.

Claim 37 and 38 stand rejected under 35 U.S.C. 102(a) as anticipated by U.S. Patent No. 4,925,493 issued to Lamoreaux on May 15, 1990. In order to sustain a valid §102 rejection, the reference must teach every element of the claim. MPEP 2131.01.

Claim 37 recites, in part, "a dry density of between 100 and 115 lbs/ft" and "an unconfined compressive strength of between 10 and 100psi." Neither of these elements are disclosed, taught or suggested by the *Lamoreaux* reference. Therefore, claim 37 is in condition for allowance.

Claim 38 recites, in part “a shear strength of between 5 and 50 psi.” This element is not disclosed, taught or suggested by the *Lamoreaux* reference. Therefore, claim 38 is not anticipated and is in condition for all allowance.



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III. Conclusion.

In view of the amendments and arguments herein, this application is believed to be in condition for allowance and favorable action is requested. Applicant reserves the right to prosecute additional claims, including claims of broader scope, in a continuation application.

The Examiner is invited to telephone the undersigned at the telephone number listed below if it would in any way advance prosecution of this case.

Respectfully submitted,

08-21-03

Date

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